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March 23, 2009

## FACSIMILE COVER SHEET

Page 1 of 16

<b>TO:</b> Mail Stop Appeal Brief-Patents Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	<b>RE:</b> Application No. 10/580,373 Filed: May 23, 2006
<b>TELEPHONE:</b> (571) 272-4722 Examiner: John J. Wilson	<b>FACSIMILE:</b> (571) 273-8300

### MESSAGE

The following document is submitted with this Cover Sheet:

Reply Brief

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**RECEIVED  
CENTRAL FAX CENTER****MAR 23 2009**PATENT  
microm27.d09**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of : Confirmation No. 2074  
Jacques PERNOT, ET AL. : Group Art Unit 3732  
Application No. 10/580,373 : Examiner: John J. Wilson  
Filing Date: May 23, 2006 : (571) 272-4722  
For a Patent for a :  
DENTAL HANDPIECE WITH A UNITARY :  
BODY AND AN ELECTRICALLY  
CONDUCTIVE AND ELASTIC  
CONNECTION ELEMENT (AS AMENDED) : March 23, 2009

**REPLY BRIEF**

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This Reply Brief is being filed pursuant to 37 C.F.R. §41.41, responsive to the "Examiner's Answer" which issued in this matter on January 22, 2009. It is respectfully requested that the U.S. Patent Office charge any fees required for the filing of this Reply Brief to Deposit Account No. 03-2405.

TABLE OF CONTENTS

Table of Contents . . . . .	2
Table of Authorities . . . . .	3
Introduction . . . . .	4
Real Party in Interest . . . . .	4
Related Appeals and Interferences . . . . .	4
Status of Claims . . . . .	5
Status of Amendments . . . . .	5
Summary of Claimed Subject Matter . . . . .	6
Grounds of Rejection to be Reviewed on Appeal . . . . .	6
Claims Appendix . . . . .	6
Argument . . . . .	7
Conclusion . . . . .	15

TABLE OF AUTHORITIES

<i>Anderson's-Black Rock, Inc. v. Pavement Salvage Co.,</i> 396 U.S. 57, 163 USPQ 673 (1969) . . . . .	12
<i>E-Pass Techs., Inc. v. 3Com Corp.,</i> 343 F.3d 1364, 67 USPQ2d 1947 (Fed. Cir. 2003) . . . . .	14
<i>Great Atlantic &amp; Pacific Tea Co. v. Supermarket</i> <i>Equipment Corp.,</i> 340 U.S. 147, 87 USPQ 303 (1950) . . . . .	12
<i>In re Gordon,</i> 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) . . . . .	13
<i>In re Merck &amp; Co., Inc.,</i> 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986) . . . . .	13
<i>In re Prater,</i> 415 F.2d 1393, 162 USPQ 541 (CCPA 1969) . . . . .	14
<i>In re Ratti,</i> 270 F.2d 810, 123 USPQ 349 (CCPA 1959) . . . . .	13
<i>KSR International Co. v. Teleflex Inc.,</i> 127 S.Ct. 1727, 82 USPQ2d 1385 (2007) . . . . .	12
<i>Sakraida v. Ag Pro, Inc.,</i> 425 U.S. 273, 189 USPQ 449 (1976) . . . . .	12

### INTRODUCTION

Responsive to the "Appeal Brief" filed on October 27, 2008, an "Examiner's Answer" was issued in connection with this appeal on January 22, 2009. This Reply Brief is filed to present further argument directed to the "Response to Argument" presented in the Examiner's Answer of January 22, 2009, addressing modified "Grounds of Rejection" presented in the Examiner's Answer.

### REAL PARTY IN INTEREST

Applicants and the Examiner are in agreement that the required statement identifying by name the real party in interest was contained in the Appeal Brief.

### RELATED APPEALS AND INTERFERENCES

Applicants and the Examiner are in agreement regarding the existence of any related appeals, interferences or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**STATUS OF CLAIMS**

Section (3) of the Examiner's Answer, on page 2, states that the status of claims contained in the Appeal Brief was incorrect, and provides what is characterized as a "correct statement of the status of the claims".

Following this, it is indicated that the status of the claims has changed resulting from an indication of allowability of dependent claims 47 to 53, 57 and 65.

It is, therefore, submitted that the differences between the status of claims given in the Appeal Brief and the status of claims given in the Examiner's Answer do not, in fact, result from an incorrect statement in the Appeal Brief, but rather result from a change in position in the Examiner's Answer.

Otherwise, Applicants and the Examiner are in agreement that the statement of the status of the claims contained in the Examiner's Answer is correct.

**STATUS OF AMENDMENTS**

Applicants and the Examiner are in agreement that the required statement contained in the Appeal Brief regarding amendments which were filed responsive to the final rejection stated in the Office Action of November 28, 2007, is correct.

**SUMMARY OF CLAIMED SUBJECT MATTER**

Applicants and the Examiner are in agreement that the required summary of the claimed subject matter contained in the Appeal Brief is correct.

**GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

Applicants and the Examiner are in agreement that the required statement of the grounds of rejection to be reviewed on appeal contained in the Appeal Brief is correct, subject to changes resulting from the changes made to the status of the claims in the Examiner's Answer. No new grounds of rejection are presented in the Examiner's Answer.

**CLAIMS APPENDIX**

Applicants and the Examiner are in agreement that the claims presented in the required Claims Appendix contained in the Appeal Brief are correct.

ARGUMENT

The Response to Argument presented in the paragraph connecting pages 5 and 6 of the Examiner's Answer provides a summary of Applicants' position relative to independent claim 33. It is submitted that this summary not only mischaracterizes the subject matter recited in the claim, but also mischaracterizes the factual arguments which have been presented by Applicants.

Turning first to the disclosure of Uejima et al., Applicants are said to have argued that the "handle and head... are separate elements not meeting the limitation of unitary, and therefore, not providing an electrically insulating envelope as claimed" (emphasis added). This incorrectly implies that the only distinction to be drawn between Applicants' claim 33 and the disclosure of Uejima et al. is that the head module 14 and the shank module 13 are formed as separate structures, and are not unitary in construction.

Referring to page 20 of the Appeal Brief, however, it is to be noted that in addition to the acknowledged distinction that Uejima et al. do not show forming the body of the dental handpiece 11 as a unitary part, Uejima et al. also do not show an "electrically insulating envelope including one part which serves as the handle and another part which constitutes the head". Consequently, there are at least two distinctions which combine to distinguish the disclosure of Uejima et al., and not



only one.

Turning next to the disclosure of Nakanishi, Applicants are said to have argued that the "unitary handle and head... [are] not directed to carrying electricity or being insulated, and therefore, also does not show or suggest an electrically insulating envelope" (emphasis added). Once again, this incorrectly characterizes Applicants' position.

Firstly, and referring to the paragraph connecting pages 22 and 23 of the Appeal Brief, what Applicants have noted is that the disclosure of Nakanishi does not in any way relate to a handpiece which is to be used for performing a root canal length measurement function, and does not specify any materials for forming the various components of the disclosed handpiece. Consequently, it would be unknown from Nakanishi precisely what materials should be used to form the handpiece, or that any of the disclosed components would be suitable for use with electrically conductive components such as those disclosed by Uejima et al.

Secondly, the characterization of the conclusion which is said to be drawn from this (i.e., "and therefore"), that Nakanishi "does not show or suggest an electrically insulating envelope", fails to evaluate the claim in the manner required by 35 U.S.C. §103(a), that being to evaluate "the subject matter as a whole". What Nakanishi does not disclose is a "body... formed as a unitary, electrically insulating envelope including one part

which serves as the handle" that contains electrically conductive components, as is later recited in claim 33, "and another part which constitutes the head" that contains electrically conductive components, as is also later recited in claim 33.

Thirdly, what Applicants' have in fact argued is that in view of the foregoing, and for other reasons discussed in the Appeal Brief on pages 22 to 24, the person of ordinary skill in the art at the time the present invention was made would not have considered combining the disclosures of Uejima et al. and Nakanishi, but would have instead rejected such a combination as inoperable.

Following the summary of Applicants' position which is presented in the Response to Argument, on page 5, reasons are provided for disagreeing with such a position.

It is first indicated that Uejima et al., "when the handle and head are assembled, does provide an electrically insulating envelope". Once again, this fails to evaluate the claim in the manner required by 35 U.S.C. §103(a), that being to evaluate "the subject matter as a whole". As has previously been indicated, claim 33 recites a "body... formed as a unitary, electrically insulating envelope including one part which serves as the handle" that contains electrically conductive components, "and another part which constitutes the head" that contains electrically conductive components. However, as is discussed in the Appeal Brief on page 20, the housing 13c of Uejima et al.

which contains the various driven elements disclosed is formed of "electrically conductive materials". As is further discussed in the Appeal Brief on page 21, it is only the film which is provided on the surface of the housing 13c of Uejima et al. that is electrically insulating.

Consequently, the part of the handpiece of Uejima et al. which serves as the body of the handle (i.e., the housing 13c) does not constitute an electrically insulating envelope for containing electrically conductive components, but rather takes the form of an electrically conductive envelope for containing the disclosed driven elements, which has an insulating film on its surface. The insulating film, therefore, does not constitute a "body... formed as a unitary, electrically insulating envelope" or a "body... including one part which serves as the handle" that contains electrically conductive components "and another part which constitutes the head" that contains electrically conductive components, and does not constitute a disclosure of the subject matter of the claim, as a whole.

It is next indicated that "it is known in the art to form such elements as one-piece". Clearly, this cannot be known from the disclosure of Uejima et al. So, presumably, this would have to be known from the disclosure of Nakanishi. However, for reasons discussed in the Appeal Brief, from page 20 to page 26, the person of ordinary skill in the art at the time the present invention was made, which is the relevant standard to be applied

here, would not have known this from the disclosure of Nakanishi.

Lines 64 to 67 of column 5 of Uejima et al. indicate that "all members relating to the... housing 13c are made of metallic materials or other electrically conductive materials" and lines 7 to 12 of column 6 further indicate that this is important so that "no external wiring is necessary for the cutting tool 15". As a consequence, to provide a handpiece having no external wiring and which is capable of performing a root canal length measurement function using the handpiece, the housing 13c of the handpiece 11 of Uejima et al. is made electrically conductive.

Recognizing that the electrically conductive material used to form the housing 13c could adversely affect operation of the measurement circuit, Uejima et al. provide the housing 13c with an insulating film (noting col. 6, lines 24 to 26) in the event that "the handpiece 11 makes contact with the tissues in the mouth or the like of the patient during root canal length measurement" (noting col. 6, lines 40 to 42).

Consequently, to avoid adversely affecting operations of the measurement circuit, Uejima et al. functionally combined a housing 13c made of an electrically conductive material with the protective outer coating of an insulating film. Uejima et al. also indicate that the handpiece 11 is to be formed of separate, "connectable and disconnectable structures to allow insertion and removal" (noting col. 4, lines 56 and 57). Such features,

however, are entirely inconsistent with the unitary head housing 12 and head housing jacket 13 disclosed by Nakanishi, representing a complete change in the respective functions of the various components forming the handpiece of Uejima et al. and the various components forming the handpiece of Nakanishi.

It is well established, however, that obviousness is found where all of the claim elements were known and one skilled in the art could have combined such elements as claimed and by known methods with no change in their respective functions. *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1739, 82 USPQ2d 1385, 1395 (2007); *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950).

It has been demonstrated that in the present case, the elements at issue have not been combined as claimed, and that the combination which has been proposed would result in a significant change in the respective functions of the elements at issue.

Moreover, and because of the conflicting functions of the various components forming the handpiece of Uejima et al. and the various components forming the handpiece of Nakanishi, it is submitted that the person of ordinary skill in the art at the time the present invention was made would not have considered a substitution of the unitary structures used by Nakanishi for the

separately connectable and disconnectable structures used by Uejima et al. For reasons previously discussed in the Appeal Brief, and in this Reply Brief, the proposed substitution would have rendered the resulting apparatus unsatisfactory for its intended purpose, *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984), and would have significantly changed the principle of operation of the resulting apparatus, *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). As a result, there would have been no reasonable expectation of success, *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

It is submitted that under such circumstances, the person of ordinary skill in the art at the time the present invention was made would not have even considered the combination of Uejima et al. and Nakanishi which is currently being proposed.

Finally, it is indicated that because the specification discloses that the envelope (8) which forms the body (2) of the handpiece (1) "can be formed in a single piece, or in multiple pieces", "there is no criticality to the unitary body forming the envelope" and that this in some way supports a finding of obviousness under 35 U.S.C. §103(a). It is submitted that this has no relevance to whether Uejima et al. and Nakanishi are appropriately combined for purposes of rejecting Applicants' claims under 35 U.S.C. §103(a).

Firstly, such an assessment would then result from limitations appearing in the specification but not recited in

the claims, which is improper. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003); *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969).

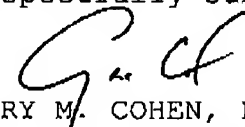
Secondly, such an assessment, once again, would not constitute an evaluation of the subject matter which the Applicants' regard as their invention, as claimed, which is also improper in view of citations which have previously been presented.

CONCLUSION

It has been demonstrated that the combination of structural elements recited in pending claims 33 to 42, 44 to 46, 54 to 56 and 58 to 64, in addition to the combination of structural elements recited in allowable dependent claims 47 to 53, 57 and 65, would not have been obvious to the person of ordinary skill in the art at the time the present invention was made in view of proposed combinations based on the disclosures of Uejima et al. and Nakanishi, as are proposed in the final Office Action of November 28, 2007, and therefore, that such claims are not appropriately subject to rejection under 35 U.S.C. §103(a).

Consequently, it has been shown that a reversal of the final rejection presented in the Office Action of November 28, 2007, is appropriate and corresponding action is earnestly solicited.

Respectfully submitted,

  
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